UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,558	07/30/2003	Brian Finlay Beaton	57983.000211	6528

21967 7590 09/18/2006	EXAMINER
HUNTON & WILLIAMS LLP	NGUYEN, CAO H

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ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/629,558	BEATON ET AL.
	Examiner	Art Unit	
	Cao (Kevin) Nguyen	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 July 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 31-61</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 31-61</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/6 ?</u>

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 31-61 are rejected on the ground of nonstatutory double patenting over claims 1-31 of U. S. Patent No. 6,608,637 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: processing element, connected to the user input device and the display, and configured to communicate with a wireless voice network for representing the communication-related tasks as objects in the tools portion, for providing the user with simultaneous access to the plurality of communications-related tasks, launching different ones of the communication-related tasks based upon selection of corresponding ones of the

communication-related task objects by the user via the user input device, and changing the

window portion based on the user selection without changing the tools portion.

Furthermore, there is no apparent reason why applicant was prevented from presenting

claims corresponding to those of the instant application during prosecution of the application

which matured into a patent. See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

. This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayless et al.

(US Patent No. 5,754,636) in view of DeLorme et al. (US Patent No. 6,321,158).

Regarding claims 1 and 37, Bayless discloses a telecommunications device for permitting

a user to perform a plurality of communication-related tasks concurrently within the

telecommunications device, comprising a user input device; a display having a tools portion and

a windows portion (see figure 5); and a processing element, processing element, connected to the

user input device and the display, and configured, to communicate with a wireless voice network

for representing the communication-related tasks as objects in the tools portion (see col. 1, lines

38-67), for providing the user with simultaneous access to the plurality of communications-

related tasks (see col. 10, lines 6-54); and changing the window portion based on the user

selection without changing the tools portion (see col. 12, lines 20-54). However, Bayless fails to

explicitly teach launching different ones of the communication-related tasks based upon

selection of corresponding ones of the communication-related task objects by the user via the

user input device.

DeLorme teaches launching different ones of the communication-related tasks based

upon selection of corresponding ones of the communication-related task objects by the user via

the user input device (see col. 4, lines 20-65). It would have been obvious to one of an ordinary

skill in the art, having the teachings of Bayless and DeLorme before him at the time the

invention was made, to modify telecommunication system device with toolbar window of

Bayless to include the integrate task object by touch screen, as taught by DeLorme. One would

have been motivated to make such a combination in order to provide a multitasking GUI for a

telecommunications device that facilitates multiple communication related tasks to occur

simultaneously while allowing user to select from task to task with ease and to enhance a user

friendly.

Regarding claim 31, DeLorme discloses wherein the user input device is touch screen element on the display and for executing one of the communication related tasks based on the user touching a corresponding one of the communication related task objects on the touch screen element (see col. 8, lines 53-67).

Regarding claim 32, Bayless discloses means for executing a plurality of the communication related tasks concurrently when a corresponding plurality of the communication related task objects are selected by the user (see col. 21, lines 13-40).

Regarding claim 33, Bayless discloses wherein the processing element sends and receives voice calls and notes (see col. 21, lines 41-58).

Regarding claim 34, Bayless discloses wherein the processing element partitions the display into the window portion and the tools portion (see col. 17, lines 12-42).

Regarding claim 35, Bayless discloses wherein the processing element provides access to the communication-related task objects in the tools portion regardless of the user selection (see col. 17, lines 12-42).

Regarding claim 36, DeLorme discloses wherein telecommunication device is a mobile telephone (see col. 2, lines 15-31). One would have been motivated to make such a combination in order to provide a multitasking GUI for a telecommunications device that facilitates multiple communication related tasks to occur simultaneously while allowing user to select from task to task with ease and to enhance a user friendly.

Regarding claim 38, DeLorme discloses wherein the telecommunications device display includes a touch screen display, and wherein the first processor element comprises a third processor element for executing one of the communication-related tasks based on the user touching a corresponding one of the communication-related task objects on the touch screen display (see col. 16, lines 35-61). One would have been motivated to make such a combination in order to provide a multitasking GUI for a telecommunications device that facilitates multiple communication related tasks to occur simultaneously while allowing user to select from task to task with ease and to enhance a user friendly.

As claims 39- 45 are analyzed as previously discussed with respect to claims 1-14 and 17-26 above.

Claim 46 differs from claims 1 and 14 in that "receiving a first user selection signal, the first user selection signal representing a selection of a first one of the plurality of communication task objects by a user; receiving a second user selection signal while executing the first communication task, the second user selection signal representing a selection of a second one of the plurality of communication task objects by the user and executing a second one of the tasks corresponding to the selected second task object while continuing to execute the first task; as recited on Bayless (see col. 28, lines 37-65).

Regarding claims 47 and 48, Bayless discloses opening a voice call window on the display screen, entering an identity of a recipient of the voice call, and establishing the voice call

with the voice call recipient and opening a note window on the display screen entering note text

for the note, the note being pre-addressed to the voice call recipient, and sending the note (see

col. 23, lines 64-67 and col. 24, lines 1-14).

Regarding claims 49 and 50, Bayless discloses wherein the second communication task

object is a voice call object, and wherein the second communication task executing step

comprises the subteps of opening a voice call window on the display screen, entering an identity

of another voice call recipient, establishing the voice call with the another voice call recipient

(see figures 30-34).

Regarding claims 51 and 52, Bayless discloses wherein the second communication

executing step further comprises the substeps of prompting the user to select either to place the

voice call recipient on hold or to terminate the voice call with the voice call recipient, and

receiving a selection signal from the user (see figures 101-104).

Regarding claims 53 and 54, Bayless discloses wherein the second communication task

executing the substep of permitting the user to converse with the caller when the second user

selection signal indicates an acceptance (see col. 31, lines 6-61).

As claims 55- 61 are analyzed as previously discussed with respect to claims 47-54
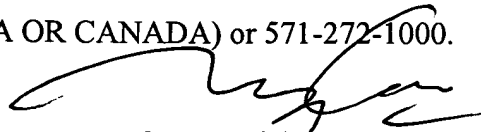
above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

09/13/06